

Attorney Docket No. IMMR-059/00US

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re application of **Allen R. Boronkay et al.**

Serial No.: 09/894,985

Examiner: Amy HE

Filed: June 27, 2001

Art Unit: 2858

Confirmation No.: 3804

For: **POSITION SENSOR WITH RESISTIVE ELEMENT**

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**REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT**

Applicants respectfully request correction of the patent term adjustment (PTA) for the above-identified application (referred to herein as the "Application"). Because the PTA determined by the U.S. Patent and Trademark Office (PTO) was incorrect due to obvious clerical errors made by the PTO, as detailed below, Applicants respectfully submit that no fee should be required by this paper.

To the extent, however, that it is deemed necessary to treat the instant Request as an Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b), the undersigned has authorized below any necessary fees (e.g., the fee set forth in 37 C.F.R. § 1.18(e)) to be charged to a deposit account.

Furthermore, to the extent that this Request is treated as an Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b), Applicants note that the period for response from the mailing date of the Notice to File Missing Parts (August 22, 2001) until the Response to the Notice to File Missing Parts was stamped received by the PTO on January 10, 2002, can be considered a "failure to engage in reasonable efforts to conclude processing or examination of [the] application," as defined in 37 C.F.R. § 1.704, because that period exceeded three months by 49 days. Applicants note, however, that Applicants' Response to the Notice to File Missing

Parts was reasonable and timely in every other sense except for the narrow definition provided in 37 C.F.R. § 1.704. Specifically, the Response to Notice to File Missing Parts was timely filed using a certificate of mailing under 37 C.F.R. § 1.8 on October 22, 2002—just two months after the mailing date of the Notice to File Missing Parts (i.e., no extensions of time were required).

### **Statement of Facts**

The Application was filed on June 27, 2001. A Notice of Allowance was mailed on September 20, 2004, and was accompanied by a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which indicated that a patent issuing from the Application was entitled to a PTA of 98 days.

On June 5, 2004, 282 days in excess of fourteen months from the filing date of the application, the first notification under 35 U.S.C. § 132 from the PTO (i.e., the first Office Action) was mailed. The PTO's Patent Application Information Retrieval (PAIR) system indicates that any PTA for patent issuing from the above application should be increased by 282 days for this delay by the PTO. A copy of a printout from PAIR System showing the PTA for the Application is attached as Exhibit A. The PAIR System also indicates that the PTA should be reduced by two periods of alleged delay by Applicants: the first for 89 days and the second for 95 days.

Applicants respectfully submit, however, that the PTO incorrectly calculated the PTA because of at least three obvious clerical errors:

1. The PTO failed to add a 54-day period of delay by the PTO to the PTA because the date of receipt of the Applicants' reply to the first Office Action was incorrectly recorded in the PAIR system;
2. The PTO miscalculated a first period of alleged delay by Applicants as 89 days instead of 49 days because the date of receipt of Applicants' response to the Notice to File Missing Parts was incorrectly recorded in the PAIR system; and
3. The PTO misapplied a second period of alleged delay by Applicants, subtracting 95 days from the PTA when none should have been subtracted, because the date of receipt of Applicants reply to the first Office Action was incorrectly recorded in the PAIR system.

The PAIR system indicates that a response to the Notice to File Missing Parts was received on February 19, 2002 (i.e., the date the application was indicated as "complete" by the PAIR system) (*see* Exhibit A). Applicants submit, however, that this response was timely filed on October 22, 2001, and was received by the PTO, at the latest, on January 10, 2002, as evidenced by the stamped postcard receipt from the PTO (attached as Exhibit B).

The PAIR system indicates that a reply to the first Office Action was filed by Applicants on December 9, 2003 (*see* Exhibit A). Applicants submit, however, this reply was received by the PTO on September 4, 2003, as evidenced by the stamped postcard receipt from the PTO (attached as Exhibit C).

Applicants respectfully submit that as a result of the obvious clerical errors noted above, the PTA was incorrectly calculated as 98 days, instead of the correct 287 days.

#### **Correct Calculation of PTA**

The PTA for the Application should be increased from 98 days to 287 days under 37 C.F.R. § 1.702(a), because the calculation performed by the PAIR System (1) failed to add a 54-day period of delay by the PTO to the PTA; (2) miscalculated a first period of alleged delay by Applicants as 89 days instead of 49 days; and (3) misapplied a second period of alleged delay by Applicants, subtracting 95 days from the PTA when none should have been subtracted. Accordingly, the correct PTA for the Application should be at least 287 days.

#### **PTA Legal Standard.**

The term of a patent will be increased under 37 C.F.R. § 1.702(a) for failure of the PTO to take certain steps within specified time frames. More specifically, 37 C.F.R. § 1.702(a) states in part:

(a) *Failure to take certain actions within specified time frames.*

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 ***not later than fourteen months after the date on which the application was filed*** under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 *not later than four months after the date on which the reply was filed* or the appeal was taken[.]

37 C.F.R. § 1.702(a) (emphasis added).

The number of days added to a patent term for failure by the PTO to act on the application within fourteen months of the filing date and respond to a reply within four months is specified in 37 C.F.R. § 1.703(a), which states in part:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first; [and]

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

37 C.F.R. § 1.703(a).

Any adjustment of the term of a patent calculated under 37 C.F.R. § 1.703(a) is subject to reduction as specified in 37 C.F.R. § 1.704, which states in parts (a) and (b):

(a) The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), ... an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of *any periods of time in excess of three months* that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request ...

37 C.F.R. § 1.704(a)-(b) (emphasis added).

37 C.F.R. § 1.704(c) also sets forth a number of circumstances that constitute a failure to engage in reasonable efforts to conclude prosecution, none of which are applicable to the Application.

The PTA of a patent is calculated pursuant to 37 C.F.R. § 1.703(f), which states, in part:

(f) ... The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

37 C.F.R. § 1.703(f).

*The PTO failed to add a 54-day period of delay by the PTO to the PTA.*

The time period from the filing date of the application (June 27, 2001) until the first notification under 35 U.S.C. § 132 (the first Office Action mailed on June 5, 2003) exceeds fourteen months by 282 days, which period appears to have been correctly calculated by the PTO, as mentioned above (*see* Exhibit A). Thus, the PTA of the term of any patent issuing from the Application should be increased by at least 282 days pursuant to 37 C.F.R. § 1.702(a)(1).

Additionally, however, the PTA should be increased pursuant to 37 C.F.R. § 1.702(a)(2) by a period of 54 days, by which the time period for the PTO's response to Applicants' reply to the first Office Action exceeded four months. Specifically, Applicants filed a reply to the first Office Action on September 4, 2003 (*see* Exhibit C), and the date of this reply was incorrectly recorded in the pair system as December 9, 2003 (*see* Exhibit A). The PTO's response to Applicants' reply was a final Office Action mailed on February 23, 2004 (*see* Exhibit A). Because the final Office Action was mailed within four months of the incorrectly recorded reply date (i.e., within four months of December 9, 2003), the PAIR system calculated no delay for this period of response (*see* Exhibit A).

The mailing date of the final Office Action (February 23, 2004) exceeds four months from the filing date (September 4, 2003) of Applicants' reply to the first Office Action by 54 days. Accordingly the PTA of the Application should be increased under 37 C.F.R. § 1.702(a)(2) by 54 days in addition to the 282 days calculated pursuant to 37 C.F.R. § 1.702(a)(1).

The PTO miscalculated a first period of alleged delay by Applicants as 89 days instead of 49 days.

Pursuant to 37 C.F.R. § 1.704, the period by which the term of any patent issuing from the Application is extended under 37 C.F.R. § 1.702 can be reduced for any failure of Applicants to “engage in reasonable efforts to conclude prosecution” of the application. The PAIR System incorrectly reduced that PTA of the Application should be reduced by 89 days for an alleged delay by Applicants in filing a response to a Notice to File Missing Parts (*see* Exhibit A).

In calculating this alleged delay, the PAIR System indicates that the Notice to File Missing Parts was mailed on August 22, 2001, and the Application was complete as of February 19, 2002 (*see* Exhibit A). Applicants respectfully submit, however, that the date listed in the PAIR System is incorrect, and a response to the Notice to File Missing Parts was timely filed (mailed with a certificate of mailing) on October 22, 2001. Although under 37 C.F.R. § 1.703(f) certificates of mailing are not taken into account for the calculation of PTA, the response to the Notice to File Missing Parts was received in the PTO, at the latest, by January 10, 2002, as evidenced by the stamped, return-receipt postcard for that response bearing a Patent Office date stamp of January 10, 2002 (*see* Exhibit B).

The response to the Notice to File Missing Parts was received by the PTO, at the latest, 49 days after a date three months from the mailing of the Notice to File Missing Parts. Accordingly, the maximum period by which the PTA should be reduced under 37 C.F.R. § 1.704 is 49 days, and not the 89 days incorrectly calculated by the PAIR system.

The PTO misapplied a second period of alleged delay by Applicants, subtracting 95 days from the PTA when none should have been subtracted.

The PAIR System indicates that the PTA should be reduced by a second period of alleged delay of 95 days by Applicants in responding to the first Office Action. Specifically, the PAIR System indicates that the first Office Action was mailed on June 5, 2003, and the reply to the first Office Action was filed on December 9, 2003 (*see* Exhibit A). Applicants respectfully submit, however, that the date listed in the PAIR System is incorrect, and a reply to the first Office Action was filed on September 4, 2003—less than three months from the mailing date of the first Office Action. The fact that the reply to the first Office Action was filed on September

4, 2003 is evidenced by the stamped return-receipt postcard for that reply bearing a Patent Office date stamp of September 4, 2003 (*see* Exhibit C).

The reply to the first Office Action was received by the PTO, within three months from the mailing date of the first Office Action. Accordingly, the PTA should not be reduced under 37 C.F.R. § 1.704 by any additional amount related to the filing of this reply.

### **Conclusion**

Accordingly, the PTA of 98 days calculated by the PTO is incorrect, and should be changed to the correct PTA of 287 days. The correct PTA of 287 days is the total of delays by the PTO under 37 C.F.R. § 1.702(a) (i.e., 282 days + 54 days = 336 days) reduced by the total of Applicants' delays under 37 C.F.R. § 1.704 (i.e., 49 days + 0 days = 49 days), or 336 days - 49 days = 287 days.

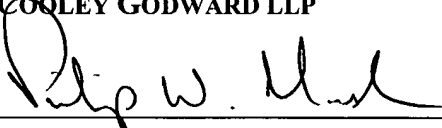
Although no fees are believed necessary by this paper, the Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: December 20, 2004

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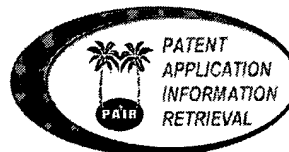
Respectfully submitted,  
**COOLEY GODWARD LLP**

By:

  
Philip W. Marsh  
Reg. No. 46,061



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**PATENT APPLICATION INFORMATION RETRIEVAL**

Patent Term Adjustment (PTA) for publication number: 09/894,985			
			Days
Filing or 371(c) Date:	06-27-2001	USPTO Delay (PTO):	282
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	184
Post-Issue Petitions (days):	+0	Total PTA:	98
USPTO Adjustment (days):	+0	Explanation of Calculations	

## Search Options

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Patent Term Adjustment History			
Date	Contents Description	PTO (days)	APPL (days)
09-20-2004	Mail Notice of Allowance		
09-17-2004	Issue Revision Completed		
09-17-2004	Notice of Allowance Data Verification Completed		
09-17-2004	Notice of Allowability		
06-24-2004	Reference capture on IDS		
06-24-2004	Information Disclosure Statement (IDS) Filed		
09-08-2004	Date Forwarded to Examiner		
06-24-2004	Request for Continued Examination (RCE)		
09-08-2004	Express Abandonment (for Entry of CPA / RCE / Rule129)		
06-24-2004	Workflow - Request for RCE - Finish		
09-01-2004	Receipt into Pubs		
08-05-2004	Receipt into Pubs		
06-24-2004	Workflow incoming amendment IFW		
06-24-2004	Workflow - Request for RCE - Begin		
05-20-2004	Workflow - File Sent to Contractor		
05-06-2004	Mail Notice of Allowance		
05-05-2004	Issue Revision Completed		
05-05-2004	Notice of Allowance Data Verification Completed		
05-05-2004	Case Docketed to Examiner in GAU		
05-05-2004	Notice of Allowability		
04-30-2004	IFW TSS Processing by Tech Center Complete		
04-30-2004	Date Forwarded to Examiner		
04-27-2004	Amendment after Final Rejection		



04-27-2004	Workflow incoming amendment IFW		
03-31-2004	Mail Examiner Interview Summary (PTOL - 413)		
03-22-2004	Examiner Interview Summary Record (PTOL - 413)		
02-27-2004	Mail Final Rejection (PTOL - 326)		
02-23-2004	Final Rejection		
12-15-2003	Date Forwarded to Examiner		
12-09-2003	Response after Non-Final Action		95
12-09-2003	New or Additional Drawing Filed		↑
06-11-2003	Correspondence Address Change		↑
06-11-2003	Change in Power of Attorney (May Include Associate POA)		↑
06-05-2003	Mail Non-Final Rejection	282	↑
06-02-2003	Non-Final Rejection	↑	
05-24-2002	Case Docketed to Examiner in GAU	↑	
04-15-2002	Case Docketed to Examiner in GAU	↑	
02-21-2002	Application Dispatched from OIPE	↑	
02-19-2002	Application Is Now Complete	↑	89
01-10-2002	Payment of additional filing fee/Preexam	↑	↑
01-10-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	↑
08-22-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	↑
08-16-2001	Correspondence Address Change	↑	
07-10-2001	IFW Scan & PACR Auto Security Review	↑	
06-27-2001	Initial Exam Team nn	↑	

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Docket No. VT1017 Application No. 09/894,985 Date: 10-22-01  
 Filing Date: 6-27-01 Express Mail No.:           
 Inventor(s): Borankay, et al.  
 For: Position Sensor with Resistive Element

The following has been received in the U.S. Patent Office on the date stamped hereon:

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| <input checked="" type="checkbox"/> Check No. <u>33933</u> in amount of \$ <u>131.00</u> | <input type="checkbox"/> Request for Non-Publication                |
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Serial No.: 09/894,985

Examiner: Amy He

Filed: June 27, 2001

Art Unit: 2858

Confirmation No.: 3804



For: **POSITION SENSOR WITH RESISTIVE ELEMENT**

1. Transmittal of Response;
2. Amendment and Reply Under 37 C.F.R. § 1.111;
3. Submission of Formal Drawings with twenty-one (21) sheets of formal drawings, including Figs. 1, 2-2A, 3-3A, 4-4A, 5, 6-6A, 7-7A, 8-8A, 9-9A, 10-10A, 11, 12-12A, 13, 14-14A, 15-15A, and 16-25; and
4. Return receipt postcard.

Dated: September 4, 2003

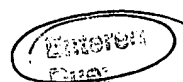
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Client/Matter No.: 302101-2165

Attorney/Secretary: PWM/dab

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